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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/692,310

10/22/2003

Boris Reydel

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8560

757 7590 05/23/2008
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EXAMINER

WITCZAK, CATHERINE

ART UNIT

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

05/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/692,310	Applicant(s) REYDEL ET AL.	
	Examiner CATHERINE N. WITCZAK	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/18/2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 2, 6-21, 23, 26, 28-38 and 41-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall (US 4,946,440) as modified by Hall.

Hall discloses a flexible introducer member (12), a sleeve (90) having a plurality of apertures (102) with a first body portion attached to the introducer and an eversible second body portion (92) moveable in response to a second member (16) sized for introduction through the introducer member; Hall discloses in column 5, line 60 that the internal passage is the duodenum; Hall discloses in Figure 3 the introducer (12) including a second passageway; Hall disclose in Figure 4 a third member (84) preloaded in the passageway of the second member (16).

Hall discloses the claimed invention but does not disclose expressly the second end of the flexible member being attached within the passageway of the second member. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to attach the second end of the flexible member to the inside of the second member because Applicant has not disclosed that attaching the second end of the flexible member to the inside of the second member provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the second end of the flexible member attached to the outer surface of the second member because it is a matter of obvious design choice as to where to attach – on the outer or inner surface- the second end of the flexible member. Therefore, it would have been an obvious matter of design choice to modify Hall to obtain the invention as specified in the claims.

2. 2. Claims 1, 3, 4, 5, 22, 23, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al (US 5,389,089) as modified by Bauer et al.

Bauer discloses a flexible introducer member (27) positioned in a portion of an endoscope (63), a polymeric sleeve (45) with a first body portion attached to the introducer and an eversible second body portion moveable in response to a second member (43) sized for introduction through the introducer member.

Bauer discloses the claimed invention but does not disclose expressly the second end of the flexible member being attached within the passageway of the second member. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to attach the second end of the flexible member to the inside of the second member because Applicant has not disclosed that attaching the second end of the flexible member to the inside of the second member provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill

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in the art, furthermore, would have expected Applicant's invention to perform equally well with the second end of the flexible member attached to the outer surface of the second member because it is a matter of obvious design choice as to where to attach – on the outer or inner surface- the second end of the flexible member. Therefore, it would have been an obvious matter of design choice to modify Bauer to obtain the invention as specified in the claims.

3. Claims 24, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall as modified by Hall.

Hall discloses the claimed invention, expect for disclosing expressly the length of the sleeve being at least 20 cm in length and the introducer and second members comprising catheter having lengths of at least 150 cm. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to vary the lengths of the sleeve and catheters because Applicant has not disclosed that these specific dimensions provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a sleeve of at least 20 cm in length and catheters of 150 cm in length because these are ranges commonly used in the art. Therefore, it would have been an obvious matter of design choice to modify Hall to obtain the invention as specified in claims 24, 25, and 27.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHERINE N. WITCZAK whose telephone number is (571)272-7179. The examiner can normally be reached on Monday through Friday, 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Catherine N Witczak/

Examiner, Art Unit 3767

/Kevin C. Sirmons/

Supervisory Patent Examiner, Art Unit 3767